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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/716,563

11/20/2000

John B. Ferber

2580-003

7535

22852

7590

06/24/2005

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
LLP

901 NEW YORK AVENUE, NW  
WASHINGTON, DC 20001-4413

EXAMINER

CHAMPAGNE, DONALD

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 06/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/716,563

Applicant(s)

FERBER, JOHN B.

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 April 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5,7-11,13-15,17,18 and 20-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,7-11,13-15,17,18 and 20-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8 April 2005 has been entered.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
3. Claims 1-5, 7-11, 13-15, 17 and 18 are rejected under 35 U.S.C. 103(a) as being obvious over Sullivan et al. (US006663105B1).
4. Sullivan et al. teaches (independent claims 1 and 7) a method and system for e-mail-based opt-in marketing, and for encouraging consumers and webmasters for participating in said marketing program, the method comprising: providing an ad server (*server 308*)<sup>1</sup> connected to an internet and a database **300** connected to said ad server, and having at least one subscriber device (*machine 304*) connected to said internet (col. 6 lines 20-24 and col. 6 line 57 to col. 7 line 2); having at least one web site connected to said internet (col. 14 lines 55-58), which reads on having at least one webmaster server connected to said internet; providing software instructions on each webmaster server for collecting an e-mail address for said subscriber device and storing said e-mail address on said database by having an operator of said subscriber device input said e-mail address (col. 17 lines 63-65) and make a selection to opt-in for delivery of a magazine from a plurality of available magazines (col. 17 lines 10-22).

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<sup>1</sup> *Server 308* serves promotional *game cards 200*, which reads on advertising (col. 6 lines 1-8).

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5. Sullivan et al. does not teach that said magazine is an ezone delivered to said email address. Because the reference invention operates online, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Sullivan et al. that the magazine be an ezone.
6. Sullivan et al. does not teach that said magazine/ezone includes an ad. Because magazines are commonly supported by publishing ads, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Sullivan et al. that said magazine/ezone include an ad.
7. Sullivan et al. also teaches (Independent claim 17) providing compensation to said webmaster (the referring website) for any referrals (col. 16 lines 14-16, col. 18 lines 23-26 and col. 19 lines 51-55) and webmasters referring webmasters (i.e., the customer/subscriber being referred from one website to the next, col. 16 lines 5-14). Sullivan et al. also teaches independent claim 13 because said webmaster/website can also be a consumer.
8. Sullivan et al. also teaches at the citations given above claims 4 and 10. Sullivan et al. also teaches claims 2 and 8 (col. 5 lines 13-15) and claims 3, 5, 9, 11 and 15 (col. 26 lines 23-26).
9. Sullivan et al. does not teach (claims 14 and 18) the form of compensation. However, Sullivan et al. does teach redeemable program points (*e-points*, col. 5 line 13) and prizes as incentives, so it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Sullivan et al. that the form of compensation also be redeemable program points/*e-points* and prizes.
10. Claims 20-23 are rejected under 35 U.S.C. 103(a) as being obvious over Sullivan et al. in view of Reilly et al. (US005740549A).
11. Sullivan et al. does not teach allowing subscribers to retrieve back issues. Because this is a common source of revenue for magazines, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add allowing subscribers to retrieve back issues to the teachings of Sullivan et al.
12. Sullivan et al. does not teach allowing subscribers to retrieve back issues with new ads. Reilly et al. teaches providing adspace with continually new ads (col. 2 line 62 to col. 3 line 10). Because Sullivan et al. teaches circumstances in which it would be desirable to have

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new ads (col. 13 lines 50-53), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Reilly et al. to those of Sullivan et al.

### **Conclusion**

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
14. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application is assigned is 703-872-9306.
15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
16. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, [www.uspto.gov](http://www.uspto.gov). At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

**DONALD L. CHAMPAGNE**  
**PRIMARY EXAMINER**

Donald L. Champagne  
Primary Examiner  
Art Unit 3622

16 June 2005